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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,309	02/22/2002	Sung Woo Yang	742-01110503	8183
25864	7590	09/28/2005	EXAMINER	
CHARLES C.H. WU			ZURITA, JAMES H .	
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IRVINE, CA 92618-3105			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/080,309

Applicant(s)

YANG, SUNG WOO

Examiner

James H. Zurita

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History

On 22 February 2002, applicant filed the instant application. There are no claims to priority.

On 24 August 2004, the Examiner rejected claims 1-7 as unpatentable over Yamonoue (US 6,745,180) in view of Garrett (US 6,473,738).

On 24 November 2004, applicant filed a response, amending claims 1 and 6.

On 7 March 2005, the Examiner issued a final rejection, rejecting claims 1-7 as unpatentable over Yamonoue (US 6,745,180) in view of Garrett (US 6,473,738).

On 5 May 2005, applicant filed a request for reconsideration, amending claims 1 and 6.

On 18 May 2005, the Examiner issued an Advisory Action.

On 21 July 2005, applicant filed a Request for Continued Examination.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 July 2005 has been entered.

Response to Amendment

On 18 July 2005, applicant amended claims 1, 6 and 7 and added claims 8-10.

Claim Objections

In claims 6 and 7, the term "...in association with..." renders the claims indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "...in association with..." will be given its broadest reasonable interpretation to mean closely connected.¹ Prior art will be interpreted to read on applicant's claims where prior art discloses a close connection between two elements.

In claims 1, 9, 10, the term "...under the control of ..." renders the claims indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term will be given its broadest reasonable interpretation to mean power or authority to guide or manage.² Prior Art will be interpreted to read on applicant's claims where actions take place at a particular device.

Claim 1 was amended to include comments that read, in part,

...whereby book orders comprising the ordering of a multiplicity of books can be efficiently done using the third set of books as a reminder to the customer in deciding whether to re-order books included in the third set of books.

However, the Examiner notes that applicant's disclosures do not mention providing *reminders to customers*. The Examiner will interpret the above limitation as being directed to some general benefit that may be provided by applicant's invention.

¹ Definition of ***association*** adj, MERRIAM WEBSTERS Collegiate Dictionary.
² ² Definition of ***control***, MERRIAM WEBSTERS Collegiate Dictionary.

Claim 1 still uses the term "...means for..." **two** times. Prior to this amendment, claim 1 used the term **three** times. Applicant amended, removing **one** occurrence. There are **two** occurrences left. As previously noted, use of the term "...means for..." appears to be an attempt to invoke 35 U.S.C. 112, sixth paragraph, to recite claim element as a means for performing a specified function. The claim will be interpreted to as being limited to a touch screen for input. The claims will be interpreted to **not** invoke the sixth paragraph.

Claim 6 contains text that appears to be an attempt to match the text amended in claim 1, steps d and f, which introduced a third set of information. The text of claim 6 does not correctly duplicate the text in Claim 1, steps d and f.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 9-11 refer to sellers and buyers who are "wholesaler" and "retailer." There is no mention of wholesalers and retailers in applicant's disclosures. The

Examiner notes that the method steps would be performed the same regardless of the labels applied to the various actors. The terms will be given their broadest reasonable interpretation to include various participants in a chain of buying and selling products such as books.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

In the rejections below, the letters (a) through (j) before various limitations are provided by the Examiner to increase readability.

Claims 1, 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano (US 6947900).

As per claim 1, Giordano discloses method(s) of searching and ordering products via the Internet (as in Fig. 1 and related text) comprising the steps of.

- (a) under control of a vendor server system, storing product identifying information for every product carried by the vendor in a main database. See, for example, Fig. 3, item 340.
- (b) under control of the vendor server system, storing product identifying information for every product previously ordered by a customer in a customer database. See, for example, Fig. 3, item 350, Col. 4, lines 57-65, Col. 5, lines 25-52.
- (c) under control of a customer system, displaying input means for entering product identifying information associated with a first set of products. See references to client

devices, as in Col. 3, lines 31-56, and references to HTML for customer input. For product identifying information associated with a first set of products, see references to categories that may be selected (entered) by customers, Col. 5, lines 7-16.

(d) under control of the vendor server system, in response to the product identifying information associated with the first set of products entered by the customer in said input means (Col. 5, lines 8-16, for example) accessing the main database to match the product identifying information associated with the first set of products entered by the customer (as matching by categories, Col. 5, lines 8-16) with the product identifying information stored in the main database and generating a search result comprising the matching product identifying information associated with a second set of products wherein the second set of products is a sub-set of the first set of products. See also Col. 4, lines 57-65.

(e) under control of the customer system, displaying said search result comprising product identifying information associated with the second set of products. See references to customized lists of products previously ordered, as in Col. 4, lines 30-65. These lists are displayed under the control of customer systems as HTML pages.

(f) under control of the vendor server system, in response to product identifying information entered by the customer in said input means, (as in Col. 5, lines 8-16) accessing the customer database to match the product identifying information entered by the customer with the product identifying information stored in the customer database and generating a previous orders result comprising the matching product

identifying information associated with a third set of products wherein the third set of products is a subset of the second set of products. See at least Col. 5, lines 52-65.

(g) under control of the customer system, displaying said previous orders result. See, for example, Col. 4, lines 30-65, Col. 5, lines 35-44. Results are displayed under the control of customer systems as HTML pages.

(h) under control of the customer system, entering product orders by selecting from the second set of products and using the third set of products as an indicator. See, for example, at least Col. 5, lines 45-61.

(i) under control of the vendor server system, in response to the product orders entered by the customer in said input means for entering product orders, generating product orders. See, for example, at least Col. 6, lines 45-31.

(j) whereby product orders comprising the ordering of a multiplicity of products can be efficiently done using the third set of products as a reminder to the customer in deciding whether to re-order products included in the third set of products. For these and other benefits, please refer to simplified reorder, as in Col. 3, lines 12-20.

As per claim 6 Giordano discloses that the steps listed above as claim 1(d) is performed in association with claim 1(f). The steps are performed in association with each other in that the results are closely connected since the previous orders result of step 1(f) is a subset of the search result of step 1(d). See Objection to claim 6.

As per claim 7, Girdano discloses displaying results on client devices 140-150, for example. Girdanno discloses that the step of displaying a search result is performed in association with a step of displaying previous orders result. The steps are performed

in association with each other in that the results are closely connected since the previous orders result of step 1(f) is a subset of the search result of step 1(d). See Objection to claim 7.

As per claim 8, Giordano discloses that a first set of products may comprise a multiplicity of products. A list is a total number to be considered or included.³ A category is any of several fundamental and distinct classes to which entities or concepts belong.⁴ By definition, these two items have multiplicity of products. See, for example, references to lists and categories of products, as in Col. 5, lines 8-16.

As per claims 1, 6-8, Giordano discloses various embodiments directed to products such as medications, Figs. 5-7b. Giordano discusses similar issues arising for other products, such as **books**. Col. 1, lines 13-44. **As per claims 1, 6-8**, Giordano **does not** provide specific examples for searching and ordering **books**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Giordano to include products such as books.

One of ordinary skill in the art at the time the invention was made would have been motivated to extend Giordano to include products such as books for the obvious reason that users can benefit from simplified reordering of products previously purchased, including books.

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano, above, in view of Garret (US 6,473,738).

³ Definition of *list*, MERRIAM WEBSTERS Collegiate Dictionary.

As per claims 2-5, Giordano discloses the methods for reordering products, and suggests applicability to other products, such as books. **As per claims 2-5**, Giordano **does not** disclose that product identifying information may comprise an ISBN (claim 2), a title (claim 3), an author (claim 4), and a subject (claim 5).

Garrett discloses that product identifying information may comprise an ISBN (claim 2), a title (claim 3), an author (claim 4), and a keyword (subject, claim 5). See, for example, at least Fig. 3 and related text, as in Col. 9, lines 4-17.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Giordano and Garret to disclose that product identifying information may comprise an ISBN (claim 2), a title (claim 3), an author (claim 4), and a keyword (subject, claim 5). One of ordinary skill in the art at the time the invention was made would have been motivated to combine Giordano and Garret to disclose that product identifying information may comprise an ISBN (claim 2), a title (claim 3), an author (claim 4), and a keyword (subject, claim 5) for the obvious reason that this type of product identifying information is relevant in searches for products such as books.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano, above, in view of Woolston (US 5,845,265).

As per claims 9-10, Giordano discloses buyers and sellers of products and suggests applicability of the invention to other products such as books.

⁴ Definition of **category**, MERRIAM WEBSTERS Collegiate Dictionary.

As per claims 9-10, Giordano does not specifically disclose that sellers (vendors) that are wholesalers of books (claim 9), and that customer systems are under control of a customer that is a retailer of books (claim10).

Woolston discloses that market makers (i.e., buyers, sellers, customers) of products such as books may be wholesalers and retailers. See, for example, Col. 16, line 27-Col. 17, line 26.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Giordano and Woolston to disclose sellers (vendors) may be wholesalers of books (claim 9), and that customer systems may be under control of a customer that is a retailer of books (claim10).

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Giordano and Woolston to disclose sellers (vendors) may be wholesalers of books (claim 9), and that customer systems may be under control of a customer that is a retailer of books (claim10) for the obvious reason that a multi-tier system may provide pricing schemes and incentives for various users to use a network to locate goods such as books and generate sales.

As per claim 11, Giordano discloses that previous order results (from claim 1(h) and now claim 11's "...indicator...") may be used by customers as an indication of a set of prior ordered books ordered, since book orders are selected from previous orders. See Abstract, for example.

As per claim 11, Giordano ***does not*** specifically disclose that the indicator (such as previous order results) is used by a ***customer that is a book retailer*** as an indication of a set of prior ordered products ordered.

Woolston discloses that market makers (i.e., buyers, sellers, customers) of products such as books may be wholesalers and retailers. See, for example, Col. 16, line 27-Col. 17, line 26.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Giordano and Walker to disclose that an indicator (such as previous order results) may be used by a customer *that is a book retailer* as an indication of a set of prior ordered products ordered.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Giordano and Walker to disclose that an indicator (such as previous order results) may be used by a customer *that is a book retailer* as an indication of a set of prior ordered products ordered for the obvious reason that such a list may be used for simplified reordering of a product previously purchased.

Response to Arguments

Applicant's arguments filed 18 July 2005 have been fully considered.

Objections the Drawings are withdrawn in view of amendment.

Double patenting rejection will be withdrawn on receipt of terminal disclaimer.

Applicant's arguments concerning the rejection under 35 USC 103(a) fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the

claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's comments concerning Yamonoue and Garrett individually are identical to those presented by applicant on 24 November 2004. Again, In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's comments concerning the combination of Yamonoue and Garrett are moot in view of new references.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Zxurita
Patent Examiner
Art Unit 3625
23 September 2005

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